

05-05-03

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PTO/SB/21 (03-03)

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Application Number	09/661,927
Filing Date	September 14, 2000
First Named Inventor	Barrett, Ronald W.
Art Unit	1639
Examiner Name	Epperson, Jon D.
Attorney Docket Number	019282-000110US

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Response to Election and Species Requirement

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Townsend and Townsend and Crew LLP

Scott L. Aussenhus

Reg. No. 42,271

Signature

Date

May 1, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

William J. Dower, et al.

Application No.: 09/661,927

Filed: September 14, 2000

For: SUBSTRATES AND SCREENING
METHODS FOR TRANSPORT
PROTEINS

Examiner: Epperson, Jon D.

Art Unit: 1639

RESPONSE TO RESTRICTION AND
SPECIES ELECTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Restriction Requirement mailed April 1, 2003. As a one month deadline was set, this response is timely filed.

RESPONSE TO RESTRICTION REQUIREMENT

In the current restriction requirement, the 5th in a series of restriction and species election requirements, the Office is for the first time requiring an additional restriction and multiple new species elections. Specifically, the Office for the first time has now further restricted claims 1-68 into another new group, contending that claims 41-45, which all directly or indirectly depend from claim 1, constitute a separate group (i.e., Group IV). The other three groups (i.e., Groups I-III) each include in part claims 1-40

and 46-68; thus, claims 1-40 and 46-68 have each been restricted by the Office into three separate groups.

In response to this restriction requirement, Applicants elect with traverse Group II that includes claims 1 (in part), 2-40 and 46-68, which are directed to methods of screening a ligand. This election is made with traverse for two reasons. First, in the current Restriction Requirement the Office continues to restrict a single claim (e.g., claim 1) into multiple inventions. This restriction continues to be made despite the fact that Applicants provided significant case law support in their September 16, 2002 response to demonstrate that restriction of a single claim into multiple inventions is contrary to controlling law. The Office Actions that Applicants have received subsequently have been bereft of an explanation as to why the Office considers this case law to be inapplicable to this application.

To reiterate, the C.C.P.A. has stated:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

See, In Re Weber, Soder and Boksay 198 USPQ 328, 331 (C.C.P.A. 1978) (emphasis added). *See also, In Re Haas* 179 USPQ 623, 624, 625 (*In Re Haas I*) (C.C.P.A. 1973) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*) (C.C.P.A. 1978).

The Office continues to take the position that restriction of a single claim is warranted because it includes distinct inventions. However, the courts have been clear that the Office cannot restrict a single claim on this basis. Specifically, the courts have ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. See, *In Re Weber, Soder and Boksay*, *In Re Haas I* and *In Re Haas II*, *supra*. As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See, *In Re Weber, Soder and Boksay* at 334.

As Applicants emphasized in their September 16, 2002 response, to be consistent with the foregoing case law and rules, if any type of election is to be imposed in this application with respect to the claims in Groups I-III, Applicants submit that it properly should be a species election requirement rather than a restriction requirement. If the Office continues to restrict claim 1 into three separate inventions, Applicants request that the Office clearly specify why it deems the foregoing case law not to be controlling with respect to this application.

The second reason for making the election of Group II with traverse is because an examination and search of the claims in Group IV (*i.e.*, claims 41-45) can be made without undue burden on the Office. As such, the claims in Group IV should be considered with the claims of elected Group II (as well as Groups I and III for the reasons just described). Because claims 41-45 are all either directly or indirectly dependent upon claim 1, by definition a full search of claim 1 will necessarily overlap with a search of the claims that depend upon it. This is the case because an independent claim necessarily encompasses the subject matter described in its dependent claims.

For each of these reasons, it is submitted that restriction of the claims into 4 groups is unwarranted. Applicant thus respectfully request that claims 1-68 be searched and examined together.

RESPONSE TO SPECIES ELECTION

With respect to the previous Supplemental Restriction Requirement (i.e., the one mailed November 13, 2002), Applicants wish to clarify that claims 1-3, 14-16, 25-37, 40-54, 56, 58, 66 and 68 read on the elected complex, CZ15-73.

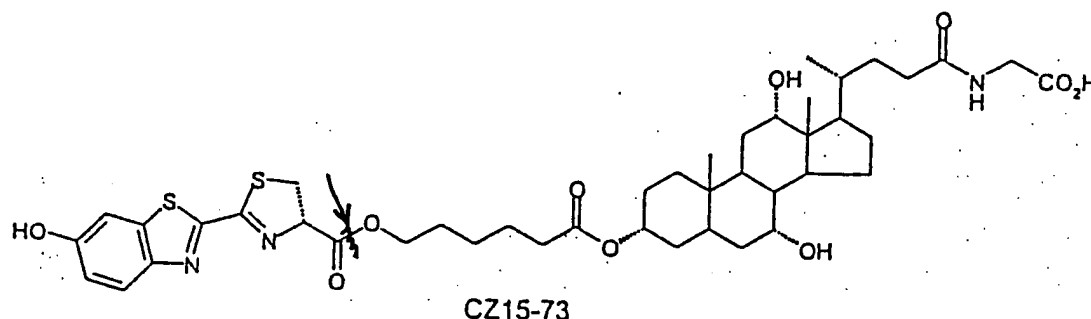
Having elected Group II, Applicants are further required to make 7 additional new species elections. In response, Applicants make the following elections without traverse:

1. Species of polar moiety: The response filed January 9, 2003 incorrectly indicated that the molecule CZ15-73 read on claim 18. Neither claims 17 or 18 read on this particular species. In view of this clarification, election of a polar moiety is not deemed necessary. If an election is nonetheless still deemed necessary, Applicants submit that an election cannot be made because no specific species are disclosed in the application.

2. Species of intracellular enzyme (see claim 18): A hydrolase enzyme is elected (see, e.g., page 34, lines 31-32). If further specificity is required, Applicants elect an esterase (see, e.g., page 33, line 30). If the Examiner is inclined to require even greater specificity, Applicants submit that this cannot be done as more specific species are not disclosed.

In indicating the claims that read on these species, it is presumed that this election has relevance only within the context of the detection scheme described in claim 14 (upon which claim 18 indirectly depends). Thus, it is presumed in indicating the claims that read on this species that the detection approach described in claim 14 applies. Assuming this to be the case, claims 1-3, 14-18, 25-37, 39-58, 64-68 read on the elected species.

3. Species of cleavable site at which an intracellular enzyme cleaves luciferin from the complex: The elected cleavage site on the previously elected CZ15-73 molecule is indicated below. In indicating the claims that read on this species, it is assumed that a complex within the library is the molecule CZ15-73 and that the site is as indicated. Assuming this to be the case, claims 1-3, 14-16, 25-37, 39-54, 56, 58, 66 and 68 read on this specific election, i.e., on this site within the context of the CZ15-73 molecule.



4. Species of enzyme from those listed in claim 15. Luciferase is elected. In indicating the claims that read on this species, it is presumed that this election has relevance only within the context of the detection scheme described in claim 14 (upon which claim 15 directly depends). Thus, it is again presumed in indicating the claims that read on this species that the detection approach described in claim 14 applies. Assuming this to be the case, claims 1-3, 14-18, 25-37, 39-58, and 64-68 read on the elected species.

5. Species of location for population of cells (see claims 25 and 36). Methods conducted within a single reaction vessel such as described in claim 25 are elected. In indicating which claims read on this particular species, it is assumed that the method is limited only in that the analysis is conducted in a single reaction vessel. Based on this assumption, claims 1-35 and 37-68 read on this species.

6. Species of transformation, particularly whether the cell population has been transformed with a DNA library encoded the elected transport protein. A transformed cell population is elected. Claims 1-50 and 52-68 read on this species.

7. Species of carrier-type protein origin (see claims 51 and 52): Carrier-type proteins expressed from an exogenous sequence are elected. Claims 1-50 and 52-68 read on this species.

So collectively claims 1-3, 14-16, 25- 35, 37, 40- 50, 52-54, 56, 58, 66 and 68 read on all 7 of the foregoing species elections.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Scott L. Ausenhus
Reg. No. 42,271

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
SLA:sla
DE 7103140 v1